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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/269,860 03/10/00 ANKENBAUER

W 4453

EXAMINER

HM22/0313

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HUTSON, R

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

03/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/269,860**

Applicant(s)  
**Ankenbauer et al.**

Examiner  
**Richard Hutson**

Group Art Unit  
**1652**



☒ Responsive to communication(s) filed on Mar 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-3, 5-7, 11-13, 15, 16, and 23-25 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-3, 5-7, 11-13, 15, 16, and 23-25 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

Applicants cancellation of claims 4, 8-10, 14 and 17-22, amendment of claims 3, 5, 6, 7, 11-13, 15 and 16, and addition of claims 23-25 in paper No: 5, filed 4/1/1999 is acknowledged.

#### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 5-7, drawn to a thermostable DNA polymerase from *Thermococcus gorgonarius*, a process for the preparation and use of said DNA polymerase.

Group II, claim(s) 11-13, 15, 16, 23, 24 and 25, drawn to a nucleic acid encoding a DNA polymerase from *Thermococcus gorgonarius*, vectors and hosts comprising said nucleic acid.

2. This application was filed as subject to 35 U.S.C. § 371 (see MPEP § 1895.01). Unity of invention as provided for by 37 C.F.R. 1.475 must be present, as cited below:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

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a. An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

b. An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- i. A product and a process specially adapted for the manufacture of said product; or
- ii. A product and a process of use of said product; or
- iii. A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- iv. A process and an apparatus or means specifically designed for carrying out the said process; or

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v. A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

c. If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph b of this section, unity of invention might not be present.

d. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c).

e. The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

3. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Southworth et al. (Proc. Natl. Acad. Sci USA 93: 5281-5285, 5/1996) teach the cloning of thermostable DNA polymerases from hyperthermophilic marine Archaea with emphasis on *Thermococcus* sp. 9°N-7 and mutations affecting 3'-5' exonuclease activity, therefore the groups listed lack the same special technical feature.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on M-F from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapy Achutamurthy (Murthy), can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Richard Hutson Ph.D.  
3/12/2001

  
**REBECCA E. PROUTY**  
**PRIMARY EXAMINER**  
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1600